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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/367,636	05/25/2000	JOSE ANTONIO R. CONDADO	5063	4589

7590 01/15/2003

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EXAMINER

KENNEDY, SHARON E

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/367,636

Applicant(s)

Condado

Examiner  
Sharon Kennedy

Art Unit  
3763



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 31, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above, claim(s) 3, 35, and 50-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-34, and 36-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on May 25, 2000 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 6) ☐ Other:

### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action or the MPEP.

#### ***Election/Restriction***

2. Claims 3, 35, 50-56 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8.

3. Applicant's election with traverse of Group I Paper No.8 is acknowledged. The traversal is on the ground(s) that there is no burden to examine the entire application. This is not found persuasive because the application comprises 119 claims originally and 60 sheet of drawings. The average balloon catheter application contains about 5 sheets and 20 claims. Obviously, it would not a simple examination, involving little or no burden to the examiner. Further, under US restriction practices, more restrictions would have been possible.

The requirement is still deemed proper and is therefore made FINAL.

#### ***Drawings***

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the micro conduits, 120, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

5. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

6. Claims 1, 2, 6, 7, 10, 11, 13-24, 26-34, 42, 43, 45-47 and 49 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Weinberger, US 5,503,613. Weinberger discloses a catheter (5) with a conduit (6) and a bulk (5a). See the lumen through the bulk which forms a path for guidewire 9.

7. Claims 1, 2 and 4 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Calderon, US 4,883,459. Calderon discloses a catheter with a conduit, and a plurality of bulks (56 and 22).

8. Claims 1, 2, 7-9, 11, 12, 13, 14, 35-41 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Baran et al., US 4,423,725. Baran discloses a bulk (balloon e) and a balloon extending there over. Note fluid conduit P extending through the bulk.

***Claim Rejections - 35 USC § 103***

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Calderon, US 4,883,459. Claim 5 recites the size of the bulk, and such is an obvious design choice (MPEP 2144.04 IV.A) in the lack of a showing of criticality. In addition, the Calderon catheter likely inherently anticipates the claimed range in view that the catheter is to be inserted in veins in the kidney, for example.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon Kennedy whose telephone number is (703) 305-0154.

January 13, 2003

  
Sharon Kennedy  
Primary Examiner